

Attorney Docket No.: **RTS-0248**
Inventors: **Bennett and Freier**
Serial No.: **09/898,556**
Filing Date: **July 3, 2001**
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REMARKS

Claims 1, 2, 4-10 and 12-15 are pending in this application. No new matter has been added by this amendment. Reconsideration is respectfully requested in view of the following remarks.

The claims of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 by the Examiner in this case. The Examiner suggests that a search of the full length target gene (SEQ. ID NO:3) is not effective to provide an adequate search of each of the individual regions claimed within SEQ ID NO:3. To provide an adequate search for compounds targeted to each of the regions claimed, the Examiner suggests that a separate search of each of the claimed regions based on the nucleotide sequence of each region would be required. The Examiner recites that claim 1 specifically claims 17 nucleotide regions within the SEQ ID NO:3 region which are targeted to and modulate the expression of HKR1. Although the compounds targeted to the regions claimed modulate expression of the same gene, the compounds targeted to each sequence region claimed are suggested to be unrelated since each compound targeted to a sequence region is suggested to be structurally and functionally independent and distinct. Each compound is suggested to have a unique nucleotide sequence based upon the sequence of the target region claimed. A

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search of more than one of the nucleotide sequences is suggested to present an undue search burden on the Patent Office. The Examiner has suggested that one sequence is considered to be a reasonable number of sequences for examination. Applicants respectfully disagree and traverse this restriction requirement.

As acknowledged by the Examiner in the November 19, 2002 action, the original presentation of the invention was an antisense targeted to a nucleic acid encoding HKR1 wherein the nucleic acid is SEQ ID NO:3.

The Applicants' interest in claiming only several, specific regions of the SEQ ID NO:3 as reflected in the amendment dated August 27, 2002, does nothing to alter the search burden placed on the Office, as the entire SEQ ID NO:3 as a target sequence should have already been (and is inferred to have been) necessarily searched by the Examiner, see page 3, of Examiner's office action dated November 19, 2002. The MPEP sets forth search guidelines for its Examiners in searching prior art. MPEP §904 states "[t]he first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited

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in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants."

The inventive concept of the present invention, as acknowledged by the Examiner in this action, is a compound 8 to 50 nucleobases in length targeted to a nucleic acid molecule encoding HKR1. HKR1 (SEQ ID NO:3) and specific regions of interest are clearly defined in the specification and at pages 80-81. As evidenced by the Office action mailed November 19, 2002, such a search covering the invention as described and claimed, including the inventive concept toward which the claims were directed, was **already** successfully completed by the Examiner prior to issuance of the restriction requirement. The Examiner has already identified prior art relating to compounds which are suggested to make obvious an antisense molecule targeted to the coding region, the translation stop codon region and the 3' - untranslated region of SEQ ID NO:3, see e.g., Oguri et al. (Reference AF on PTO form 1449) Taylor et al. (DDT, vol 4 No. 12 Dec. 1999) Milner et al. (Nature Biotechnology, Vol 15, June 1997) and Baracchini et al. (U.S. Patent No. 5,801,154). Thus, since such a search was already

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undertaken and completed, there can not be any burden whatsoever placed on the office by the Applicants amendment filed April 21, 2003 identifying specific target regions of interest in the targeted gene, which have been distinguished from the prior art.

Applicants respectfully request that this restriction requirement be withdrawn.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute nucleobases 2738 through 2757 of a 3'-untranslated region of a nucleic acid molecule encoding HKR1 of SEQ ID NO:3, with traverse.

Since Applicants had, in fact, initially presented a generic claim to a compound targeted to a nucleic acid molecule encoding HKR1, which was amended in response to the Examiner's action mailed November 19, 2002, to recite that the compound was targeted to multiple specific regions of a nucleic acid molecule encoding HKR1 of SEQ ID NO:3, Applicants respectfully request that should no prior art be found which anticipates or renders obvious the elected species (nucleobases 2738 through 2757 of a 3'-untranslated region of a nucleic acid molecule encoding HKR1 of SEQ ID NO:3), that the search will be extended to at least to those regions of the target

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gene specifically identified in claim 1 as amended on April 21, 2003.

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